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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,840	04/05/2004	Wayne Ernest Conrad	12811-384/PMdC	3679
1059	7590	08/19/2004	EXAMINER	
BERESKIN AND PARR SCOTIA PLAZA 40 KING STREET WEST-SUITE 4000 BOX 401 TORONTO, ON M5H 3Y2 CANADA			HOPKINS, ROBERT A	
			ART UNIT	PAPER NUMBER
			1724	

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/816,840	CONRAD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert A Hopkins	1724	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4,5,7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Japanese referencet(3-30).

Japanese reference teaches a vacuum cleaner comprising a cleaning head(23 in figure 2) for cleaning a surface, a cyclone container(6 in figure 3) having a wall having an inner surface and a longitudinally extending axis, a fluid inlet (17) to the at least one cyclone container, and a fluid conduit(18) integrally formed as part of the cyclone container. Japanese reference further teaches wherein the fluid conduit extends through a central portion of the cyclone container. Japanese reference further teaches wherein the fluid inlet is positioned adjacent the inner wall of the cyclone container. Japanese reference further teaches wherein the fluid conduit extends linearly.

Claims 1,2,3,4,5,7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lee(1759947).

Lee teaches a vacuum cleaner comprising a cleaning head(23) for cleaning a surface, a cyclone container(40) having a wall having an inner surface and a longitudinally extending axis, a fluid inlet( from deflector 42) to the at least one cyclone

container, and a fluid conduit(41) integrally formed as part of the cyclone container(see figure 1). Lee further teaches wherein the fluid conduit extends through a central portion of the cyclone container. Lee teaches wherein the fluid conduit includes an exit portion which extends within the cyclone container from the central portion outwardly to the fluid inlet. Lee further teaches wherein the fluid inlet is positioned adjacent the inner wall of the cyclone container.

***Allowable Subject Matter***

Claim 6, and 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 6 recites "wherein the fluid conduit is positioned exterior to the cyclone container". Both Japanese reference and Lee disclose a fluid conduit positioned interior to the cyclone container. It would not have been obvious to someone of ordinary skill in the art at the time of the invention to provide a fluid conduit positioned exterior to the cyclone container because neither Japanese reference nor Lee suggest such a modification.

Claim 8 recites "wherein the fluid conduit is positioned exterior to the cyclone container and the fluid conduit extends linearly". Both Japanese reference and Lee disclose a fluid conduit positioned interior to the cyclone container. It would not have been obvious to someone of ordinary skill in the art at the time of the invention to provide a fluid conduit positioned exterior to the cyclone container because neither Japanese reference nor Lee suggest such a modification.

Claim 9 recites "wherein the fluid conduit extends through the cyclone container to an opening in the bottom of the cyclone container and comprises an exit for the cyclone container. Lee discloses a fluid conduit which extends to a fluid inlet for the cyclone container. Japanese reference discloses a fluid conduit which extends to a top of a cyclone container. It would not have been obvious to someone of ordinary skill in the art at the time of the invention to provide a fluid conduit which extends through the cyclone container to an opening in the bottom of the cyclone container and comprises an exit for the cyclone container because neither Japanese reference nor Lee suggest such a modification. Claim 10 depends on claim 9 and hence would also be allowable upon incorporation of claim 9 into claim 1.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 11-15 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 16-20 of prior U.S. Patent No. 6,736,873. This is a double patenting rejection. Examiner notes that the limitations "for cleaning a surface" in claim 11 of the current application is a functional statement and does not provide patentable distinctness from the limitations of claim 16 of U.S. Patent No. 6,736,873. Examiner

respectfully submits that a cleaning head has an inherent function of cleaning a surface.

Claims 12-15 depend on claim 11 and hence are also rejected.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-15 of U.S. Patent No. 6,736,873. Although the conflicting claims are not identical, they are not patentably distinct from each other because the "comprising" language of claim 1 of the current application accounts for subject matter which is not included in the body of the claim. In the current claim, such additional claim language is "and positioned exterior to the at least one cyclone container", which is part of claim 12 of U.S. Patent No. 6,736,873. Also, examiner notes that the limitations "for cleaning a surface" in claim 1 of the current application is a functional statement and does not provide patentable distinctness from the limitations of claim 12 of U.S. Patent No. 6,736,873. Examiner

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respectfully submits that a cleaning head has an inherent function of cleaning a surface.

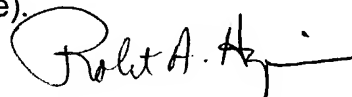
Claims 2-10 depend on claim 1 and hence are also rejected.

Claims 11-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-24 of U.S. Patent No.6,141,826. Although the conflicting claims are not identical, they are not patentably distinct from each other because "comprising" language of claim 1 of the current application accounts for subject matter which is not included in the body of the claim. In the current claim , such additional claim language is "and an outlet in communication with a source of suction". Claims 12-15 depend on claim 11 and hence are also rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A Hopkins whose telephone number is 571-272-1159. The examiner can normally be reached on Monday-Friday, 7am-4pm, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert A Hopkins  
Primary Examiner  
Art Unit 1724

Rah  
August 17, 2004